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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,014	03/30/2004	Eiji Kimura	4468-017B	2801
7590	11/17/2005		EXAMINER	
LOWE HAUPTMAN GILMAN & BERNER, LLP			NGUYEN, TU T	
Suite 300			ART UNIT	PAPER NUMBER
1700 Diagonal Road				2877
Alexandria, VA 22314				

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/812,014	KIMURA, EIJI	
	Examiner Tu T. Nguyen	Art Unit 2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 November 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 4-6, 12, 15, 21, 24 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 4-6, 12, 15, 21, 24 and 30-32 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 07 March 2005 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. 09/877,202.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

**DETAILED ACTION**

***Response to Arguments***

Applicant's arguments, see applicant's amendment, filed 11/07/2005, with respect to the rejection(s) of claim(s) 4-6,12,15,21,24,30-32 under 103 rejection have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of copending application 10/812,012.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12,21,30,32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10,19,28,32 of copending Application No. 10/812,012. Although the conflicting claims are not identical, they are not patentably distinct from each other.

With respect to claim 12, claim 10 of application 10/812,012 ('012 hereinafter) discloses a system comprises: an optical/electrical converting element, a variable wavelength light source, a signal source, a light modulating element, a further optical/electrical converting element.

Claim 10 of '012 does not explicitly disclose the claimed optical/electrical converting process. Since claim 10 of '012 discloses using an element for converting a signal into an electrical signal, it would have been obvious that '012 would have to have a process to perform the converting function.

With respect to claims 21,30,32, the claims disclose the same subject matter taught in claims 19,28,32 of copending application '012 except for the converting process. Refer to discussion in claim 12 above for the converting process.

Claims 4-6,15,24,31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5-6,10,19,28,32 of copending Application No. 10/812,012 in view of Horiuchi et al (6,594,003).

This is a provisional obviousness-type double patenting rejection.

With respect to claims 4-6,15,24,31, claims 5-6,10,19,28,32 of copending Application No. 10/812,012 discloses the claimed limitations: a first optical/electrical converting element, a second variable wavelength light source, a signal source for generating a reference electrical signal, a third optical/electrical converting element for converting the reflected light from the second incident light.

Application No. 10/812,012 does not disclose a first variable wavelength light source, a first light modulating element, a first optical/electrical converting element, optical/electrical converting processes, the second optical/electrical converting element. Horiuchi discloses a system comprising: a first variable wavelength light source 140 (fig 50 for generating a first variable wavelength  $\lambda_b$  light; a first light modulating means 142 (fig 5) for introducing into said first optical transmission line 116 (fig 5) a first incident light obtained by modulating said first variable wavelength light with a frequency of a first electrical signal 134 (fig 5), wherein said first incident light exits from said first

optical transmission line as a first outgoing light; a first optical/electrical converting element 144 (fig 5) for converting by a first optical/electrical conversion process, the first outgoing light into a second electrical signal; a second optical/electrical converting element 132 (fig 5) for converting the second outgoing light into the first electrical signal and for outputting the first electrical signal into said first light modulating element. It would have been obvious to modify Applicant No. 10/812,012 with the system as taught by Horiuchi to facilitate the measuring. Further, '012 does not explicitly disclose the claimed optical/electrical converting process. Refer to discussion in claim 12 above for the process.

Claims 4-6,12,15,21,24,30-32 would be allowable if Applicant file in a terminal disclaimer to overcome the Double Patenting rejection discussed above. Refer to office action mailed on 06/06/2005 for the reason for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu T. Nguyen whose telephone number is (571) 272-2424. The examiner can normally be reached on T-F 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Toatley Jr. can be reached on (571) 272-2800 Ext. 77. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tu T. Nguyen  
Primary Examiner  
Art Unit 2877

11/15/2005